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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,049	07/25/2001	Andreas Dieberger	YOR9-2001-0385 (8728-520)	6021
46069 7590 03/07/2007 F. CHAU & ASSOCIATES, LLC 130 WOODBURY ROAD WOODBURY, NY 11797			EXAMINER VAN BRAMER, JOHN W	
			ART UNIT 3622	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/07/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/915,049	<b>Applicant(s)</b> DIEBERGER ET AL.	
	<b>Examiner</b> John Van Bramer	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 22, 2006 has been entered.

### ***Response to Amendment***

2. The amendment filed on December 22, 2006, cancelled no claims. No claims were added and claims 1, 8, 14, 20, and 21 were amended. Thus the currently pending claims remain Claims 1-21.

### ***Claim Rejections - 35 USC § 112***

3. The amendment filed on December 22, 2006 has overcome the 35 U.S.C. 112 rejection directed towards a step for displaying content. Thus, the examiner hereby withdraws the rejection.
4. The amendment filed on December 22, 2006 fails to overcome the rejection of Claims 1 – 21 under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. Thus the rejection is maintained. In order for the rule specifying,

"at least one spectator be detected" to be triggered two things must occur. First, a step of detecting utilizing the technologies disclosed in the specification (IR tags, RFID tags, etc.) must occur. Then, a mechanism for determining that the technology that is detected is in the possession of a spectator. Based upon the applicant's arguments, and reluctance to claim providing a specific RFID tag or the like that works with the invention, the examiner infers that the applicant intends the invention to work with any RFID tag or the like. This being the case, there is no way the applicant can guarantee that the technology that triggered the rule is in the possession of a spectator. The technologies claimed are so ubiquitous that the rule may be triggered by any number of objects that contain such technologies such as automobiles, and items for sale in a retail outlet even when no spectator is present. As an alternative to the examiners previous suggestion for to correcting the deficiencies in the claims, the applicant could claim "detecting the presence of an RFID tag, IR tag, or proximity indicator" and a triggered rule specifying that "at least one RFID tag, IR tag, or proximity indicator is detected". However, the applicant needs to be careful how broadly these two required steps are claimed. A claim not directed towards the technologies specifically claim in the specification may present scope of enablement issues. There are numerous other technologies, such as facial recognition, that could be used for the detecting and triggering steps that are not supported by the specification.

***Claim Rejections - 35 USC § 101***

5. The amendment filed on December 22, 2006 has corrected the 35 U.S.C. 101 deficiencies detailed in the Office Action dated March 23, 2006. Thus, the examiner hereby withdraws the rejection.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1 – 9, and 13 - 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Cohen (U.S. Patent Number: 6,060,993).

Claim 1: Cohen discloses a method for displaying content on a display device:

- a. Retrieving a plurality of rules, each rule associated with displaying content, wherein the content is provided by a content provider. (Col 4, lines 37 – 46)
- b. Updating a plurality of device parameters. (Col 4, lines 14 – 26)
- c. Triggering at least two rules of the plurality of rules by the plurality of device parameters. (Col 4, lines 54 – 60; and Col 4, line 64 through Col 5, line 3)
- d. Executing the at least two triggered rules, a first triggered rule for causing the display of the content on the display device, a second triggered rule

specifying that at least one spectator be detected. (Col 4, lines 54 – 60; Col 4, line 64 through Col 5, line 3; and Col 5, lines 10-24) (The motor vehicle density of traffic inherently indicates that a spectator is present.)

- e. Determining a fee according to the triggered rules, wherein the content provider is charged a fee. (Col 5, lines 10 – 23)

Claim 2: Cohen discloses the method of claim 1, wherein at least one rule is defined by the content provider to dynamically control the display of the content according to the device parameters. (Col 5, lines 10 – 23)

Claim 3: Cohen discloses the method of claim 1, wherein the step of executing the at least two triggered rules further comprises the step of receiving a rule trigger from one of a location handler and a signal handler. (Col 4, lines 54 – 60)

Claim 4: Cohen discloses the method of claim 3, wherein the step of receiving a rule trigger from the location handler further comprises the step of updating a positional parameter. (Col 4, lines 54 – 60)

Claim 5: Cohen discloses the method of claim 3, wherein the step of receiving a rule trigger from the signal handler further comprises the steps of:

- a. Interpreting an input signal (Col 5, lines 15 – 26)
- b. Generating a programmatic event flag (Col 4, lines 54 – 60)

Claim 6: Cohen discloses the method of claim 5, wherein the step of generating a programmatic event flag further comprises the step of generating one of a reply signal and the rule trigger. (Col 4, lines 54 – 60)

Claim 7: Cohen discloses the method of claim 1, further comprising the step of providing an overriding rule blocking the display of content corresponding to the rule and the determination of the fee, wherein the overriding rule is defined by the device owner. (Col 5, lines 10 – 23)

Claim 8: Cohen discloses the method of claim 1, wherein the step of determining a fee further comprises the steps of:

- a. Determining a value for each of the device parameters (Col 1, lines 22 – 45; and Col 5, lines 10 – 23)
- b. Determining at least one device parameter satisfying the triggered rule (Col 1, lines 22 – 45; and Col 5, lines 10 – 23)
- c. Determining the fee according to value of the device parameters satisfying the triggered rule. (Col 1, lines 22 – 45; and Col 5, lines 10 – 23)

Claim 9: Cohen discloses the method of claim 8, further comprising the step of charging the fee to a client providing content to be displayed. (Col 5, lines 10 – 23)

Claim 13: Cohen discloses the method of claim 1, wherein the fee is charged to a user for the use of the display. (the user is the advertiser using the service) (Col 5, lines 10 – 23)

Claim 14: Cohen discloses a method for displaying content on a mobile display device:

- a. Retrieving a plurality of rules stored in the mobile display device from a rule server. (Col 4, lines 37 – 46)
- b. Determining a value for each of a plurality of device parameters. (Col 1, lines 22 – 45; and Col 5, lines 10 – 23)
- c. Executing each rule satisfied by the device parameters. (Col 4, line 54 through Col 5, line 3)
- e. Displaying content according to each satisfied rule, wherein a first satisfied rule specifies that a spectator be detected and a second satisfied rule specifies a certain demographic of the spectator is determined. (Col 4, line 54 through Col 5, line 3; and Col 5, lines 10-24)
- f. Determining a monetary charge based on the content displayed and the satisfied rules, which triggered the display of the content. (Col 2, lines 22 – 45; and Col 5, lines 10 – 23)



Claim 15: Cohen discloses the method of claim 14, wherein at least one rule is defined by a content provider to dynamically control the display of the content according to the device parameters. (Col 5, lines 10 – 23)

Claim 16: Cohen discloses the method of claim 14, further comprising the step of receiving a rule trigger from one of a location handler and a signal handler. (Col 4, lines 54 – 60)

Claim 17: Cohen discloses the method of claim 16, wherein the step of receiving a rule trigger from the location handler further comprises the step of updating a positional parameter. (Col 4, lines 54 – 60)

Claim 18: Cohen discloses the method of claim 16, wherein the step of receiving a rule trigger from the signal handler further comprises the steps of:

- a. Interpreting an input signal. (Col 4, lines 15 – 26)
- b. Generating a programmatic event flag. (Col 4, lines 54 – 60)

Claim 19: Cohen discloses the method of claim 18, wherein the step of generating a programmatic event flag further comprises the step of generating one of a reply signal and the rule trigger. (Col 4, lines 54 – 60)

Claim 20: Cohen discloses a program storage device readable by machine, tangibly

embodying a program of instructions executable by the machine to perform method steps for displaying content on a display device, the method steps comprising:

- a. Retrieving a plurality of rules for the display of content. Wherein the content is provided by a content provider. (Col 4, lines 37 – 46)
- b. Updating a plurality of device parameters. (Col 4, lines 14 - 26)
- c. Determining a rule trigger for triggering at least one rule of the plurality of rules according to the plurality of device parameters. (Col 4, line 54 through Col 5, line 3)
- d. Executing a trigger rule for causing the display of the content on the display device, wherein the triggered rule specifies that at least one spectator be detected, wherein the spectator is detected by a receiver which detects an identification tag provided to the spectator. (Col 4, line 54 through Col 5, line 3; and Col 5, lines 10-24)
- e. Determining a fee according to at least one device parameter upon executing a rule for the display of content, wherein the content provider is charged the fee. (Col 5, lines 10 – 23)

Claim 21: Cohen discloses the program storage device of claim 18, wherein the method step of determining a fee further comprises the steps of:

- a. Determining a value for each of the device parameters. (Col 1, lines 22 – 45; and Col 5 lines 10 – 23)

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- b. Determining at least one device parameter satisfying the triggered rule. (Col 1, lines 22 – 45; and Col 5 lines 10 – 23)
- c. Determining the fee according to value of the device parameters satisfying the triggered rule. (Col 1, lines 22 – 45; and Col 5 lines 10 – 23)

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 10 – 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen (U.S. Patent Number: 6,060,993).

Claims 10 and 11: Cohen discloses the method of claim 8, further comprising the step of apportioning fees. However, Cohen is silent with regard to various permutations in which fee apportionment might entail. The teachings of Cohen describe the display system itself and not who owns and operates the display system. It would have been obvious to one of ordinary skill in the art at the time of the invention that the service provider (entity that runs, operates and/or owns the display device) would need to reimburse the third party carrier (i.e. taxi company, trucking company, etc) for allowing them to put the display on the

carrier's physical property (i.e. taxi cabs, trucks, buses, etc.). One would have been motivated to institute such a reimbursement in order to provide the third party carrier with an incentive to install the display to help in the defrayment of operating costs.

Claim 12: Cohen discloses the method of claim 8, further comprising the step of apportioning the fees. However, Cohen is silent with regard to various permutations in which fee apportionment might entail. The teachings of Cohen describe the display system itself and not who owns and operates the display system. It would have been obvious to one of ordinary skill in the art at the time the invention was made that when the device is sold as a stand alone device, in which various third party carriers (i.e. Taxi companies, trucking companies, etc.) can purchase and install, a fee would need to be paid to the plurality of owners, by the service provider (entity that operates the advertisement distribution hardware), in order to be provided the opportunity to display advertisements on their mobile display unit. One would have been motivated to provide such a reimbursement in order to maximize the number of display units on which it can provide advertisements, and as a result maximize the fees it charges to entities wishing to advertise on the service.

***Response to Arguments***

10. Applicant's arguments filed June 29, 2006 have been fully considered but they are not persuasive.
- a. The applicant argues that Cohen does not teach executing a first trigger rule for displaying content and a second trigger rule for detecting a spectator. However, Cohen discloses in Col 5, lines 10-24 that the vehicle density of traffic, which inherently includes a spectator) is monitored and based upon this parameter the display of advertising is triggered.
  - b. The applicant argues that Cohen does not teach the display based upon the triggering of an additional demographic indicator of the spectator. However, Cohen discloses that the advertisements are based upon the location of the spectator which is a demographic indicator.(Col 4, lines 54-60)
  - c. The applicant argues that Cohen does not teach triggering a display based upon an identification tag associated with the spectator. However, Cohen discloses that the vehicle density as well as weather, time etc are used to determine the advertisement displayed. Since, the applicant does not specify a specific type of identification tag and does not recite a step of actively providing spectators with an identification tag the mere act of associating a parameter with the spectator such as the time of day is sufficient to satisfy the limitations imposed by the claim. For example, Cohen is able to identify, for billing purposes, that the ad was displayed to 30 vehicles in zone 3 at 6:00 am. Thus, the individual spectator has been identified as a vehicle in zone 3

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at 6:00 am. The examiner suggests the applicant amend the claim to specifically require that a physical identification card is being provided to a spectator and the detection of the presence of such a card.

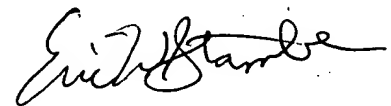
### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
jvb

  
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